

ESTTA Tracking number: **ESTTA788643**

Filing date: **12/12/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	ViiV Healthcare Company
Granted to Date of previous extension	12/11/2016
Address	Five Moore Drive Research Triangle Park, NC 27709 UNITED STATES
Attorney information	Paul C Llewellyn Kaye Scholer LLP 250 West 55th Street New York, NY 10019-9710 UNITED STATES paul.llewellyn@kayescholer.com Phone:2128367828

Applicant Information

Application No	86678600	Publication date	06/14/2016
Opposition Filing Date	12/12/2016	Opposition Period Ends	12/11/2016
Applicant	Temple Otorongo LLC 70 South Orange Avenue, Suite 205 Livingston, NJ 07039 UNITED STATES		

Goods/Services Affected by Opposition

Class 005. First Use: 0 First Use In Commerce: 0
All goods and services in the class are opposed, namely: Pharmaceutical preparations for the treatment of neurological and psychological conditions

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
False suggestion of a connection with persons, living or dead, institutions, beliefs, or national symbols, or brings them into contempt, or disrepute	Trademark Act Section 2(a)

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	2248121	Application Date	03/25/1997
Registration Date	05/25/1999	Foreign Priority	NONE

		Date	
Word Mark	ZIAGEN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 005. First use: First Use: 1999/01/06 First Use In Commerce: 1999/01/06 anti-viral pharmaceutical preparations and substances, sold under prescription only		

Attachments	Notice of Opposition - AYAGEN.pdf(11228 bytes)
-------------	---

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/paul c llewellyn/
Name	Paul C Llewellyn
Date	12/12/2016

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

VIIV HEALTHCARE COMPANY,

Opposer,

v.

TEMPLE OTORONGO LLC,

Applicant.

Opposition No. _____

Mark: AYAGEN & design

Serial No: 86678600

Filed: June 13, 2015

Published: June 14, 2016

NOTICE OF OPPOSITION

Opposer, ViiV Healthcare Company (“Opposer” or “ViiV”), a company organized under the laws of Delaware with a place of business at Five Moore Drive, Research Triangle Park, NC 27709, believes it will be damaged by the registration of the mark AYAGEN shown in Application Serial No. 86678600, and hereby opposes the same.

As grounds for opposition, Opposer alleges that:

1. ViiV is a research-based pharmaceutical company in the business of discovering and developing advances in treatment and care for people living with HIV.
2. ViiV and its predecessors in interest have used the mark ZIAGEN on pharmaceutical products, including anti-viral pharmaceutical preparations, since at least 1999.
3. ViiV is the owner of U.S. Trademark Registration No. 2248121 on the Principal Register for the trademark ZIAGEN® covering “anti-viral pharmaceutical preparations and substances, sold under prescription only” in International Class 5.
4. The registration for the ZIAGEN mark is valid, subsisting, and incontestable, and ViiV hereby gives notice in accordance with Trademark Rule of Practice 2.122(d)(2) that it will

rely thereon as evidence in this proceeding, and a status copy thereof showing present title will be introduced into evidence on its behalf during ViiV's testimony period.

5. The ZIAGEN mark is inherently distinctive; it is a fanciful and coined term with no meaning other than to identify ViiV's anti-viral pharmaceutical products.

6. Since its ZIAGEN products were introduced in 1999, ViiV and its predecessors and licensees have spent substantial time, effort and money to promote the sale of pharmaceutical products in the United States under the ZIAGEN mark, and have sold and continue to sell substantial quantities of ZIAGEN pharmaceutical products in the United States.

7. Despite ViiV's prior and long established common law and statutory rights in the ZIAGEN mark, and with at least constructive notice of ViiV's federal trademark registration, Temple Orotongo LLC ("Applicant") applied to register the mark AYAGEN for "Pharmaceutical preparation for the treatment of neurological and psychological conditions" in International Class 5, as set forth in Application Serial No. 86678600 (the "Subject Application").

8. ViiV's ZIAGEN mark has priority over Applicant's AYAGEN mark because the filing date of ViiV's trademark application was March 25, 1997, and ViiV's date of first use was at least as early as 1999, well prior to the priority date of the Subject Application.

9. Applicant's applied-for AYAGEN mark is substantially or highly similar to the ZIAGEN mark in sound, appearance and commercial impression.

10. The goods set forth in the Subject Application are at least in part legally identical to the goods for which ViiV's ZIAGEN mark is registered and used.

11. The goods set forth in the Subject Application are highly related to the goods for which ViiV's ZIAGEN mark is registered and used.

12. Some viral infections which could be treated with anti-viral pharmaceutical preparations affect the nervous system or lead to neurological conditions.

13. Some patients who are prescribed anti-viral pharmaceutical preparations also suffer from neurological or psychological conditions that might be treated with the goods covered by the Subject Application.

14. On information and belief, Applicant's AYAGEN goods will be sold and distributed through the same channels of trade as ViiV's ZIAGEN goods.

15. As a result, if Applicant begins using the mark AYAGEN in commerce in conjunction with the goods set forth in the Subject Application, in light of the similarity of the ZIAGEN and AYAGEN marks and the similarity of the parties' respective goods, channels of trade and target patient populations (among other reasons), many consumers, patients, prescribers and others who encounter Applicant's mark are likely to think that the goods offered under the AYAGEN mark, or the company that offers Applicant's products, are authorized by, sponsored by, licensed by, affiliated with or related to the company that offers ViiV's ZIAGEN products, or that the ZIAGEN and AYAGEN products are the same or are otherwise related.

16. Accordingly, Applicant's AYAGEN mark, if used in conjunction with the goods set forth in the Subject Application, is likely to cause confusion, mistake, or to deceive as to the origin, source, sponsorship or affiliation of Applicant's goods.

17. Applicant's AYAGEN mark so resembles ViiV's previously used and registered ZIAGEN mark as to be likely, when applied to the goods set forth in the Subject Application, to cause confusion, mistake or deception within the meaning of 15 U.S.C. § 1052(d).

18. ViiV previously has used the trademark ZIAGEN throughout the United States in connection with anti-viral pharmaceutical preparations, such that ZIAGEN became a name or

identity of substantial reputation that is closely identified with ViiV. Accordingly, Applicant's applied-for mark AYAGEN is likely, when applied to the goods set forth in the Subject Application, to point uniquely to ViiV and to falsely suggest a connection with the ViiV within the meaning of 15 U.S.C. § 1052(a).

WHEREFORE, for all of the foregoing reasons and for such other reasons as the Board determines are appropriate, ViiV respectfully prays that this Opposition be sustained and that the Subject Application be refused.

The Patent and Trademark Office and Trademark Trial and Appeal Board are hereby authorized to collect any fees necessitated by this Notice of Opposition from the deposit account of ViiV's attorneys, Kaye Scholer LLP, Deposit Account No. 11-0228.

Dated: December 12, 2016

Respectfully submitted,

/paul c llewellyn/
Paul C. Llewellyn
KAYE SCHOLER LLP
250 West 55th Street
New York, New York 10019-9710
Telephone: (212) 836-7828

John P. Rynkiewicz
KAYE SCHOLER LLP
901 Fifteenth Street, N.W.
Washington, DC 20005
Telephone: (202) 682-3671

*Attorneys for Opposer
ViiV Healthcare Company*

CERTIFICATE OF SERVICE

I certify that the foregoing Notice of Opposition is being electronically filed with the United States Patent and Trademark Office on December 12, 2016 and that a true and correct copy of the foregoing was served by first-class mail, postage prepaid, on the correspondent of record for Applicant, namely:

Michael B. Farber, Esq.
Ditthavong & Steiner
44 Canal Center Plz Ste 322
Alexandria, VA 22314-1552

Jennifer Worksman